REMARKS

At the time of the Office Action dated December 30, 2005, claims 1-16 were pending and rejected in this application.

CLAIMS 1-16 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY CHASE ET AL., U.S. PATENT PUBLICATION NO. 2004/0111514 (HEREINAFTER CHASE)

On pages 2-5 of the Office Action, the Examiner asserted that Chase discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

At the outset Applicants recognize that the present Application and Chase are similar in many respects. Both Chase and the present Application share two common inventors and both disclosures are directed to similar subject matter. Notwithstanding these similarities, Applicants respectfully submit that the Examiner has failed to establish that Chase identically discloses the claimed invention within the meaning of 35 U.S.C. § 102.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.[1] As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history,

[1] In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

and (c) identify corresponding elements disclosed in the allegedly anticipating reference.[2] This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in Chase being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).[3]

Claims 1 and 11

To teach all of the limitations recited in claims 1 and 11, the Examiner has merely pointed to certain coefficients (i.e., M, T, α) and to paragraphs [0037], [0040], [0042], and [0043] and asserted that these paragraphs disclose the claimed invention. The manner in which the Examiner conveyed the statement of the rejection, however, has not "designated as nearly as practicable" the particular parts in Chase being relied upon in the rejection.

The last line of claim 1 recites "further computing an optimal cache size for said Zipf alpha coefficient, trace footprint and optimal hit rate." A review of the paragraphs cited by the Examiner yields no mention of calculating an optimal cache size based upon the recited paragraphs. Moreover, a review of these paragraphs also fails to yield any mention of calculating an optimal cache size. The phrase "optimal cache size" is wholly absent from the teachings of Chase. Therefore, the Examiner cannot properly asset that Chase identically discloses "computing an optimal cache size," as recited in claims 1 and 11. Furthermore, even if

[2] Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.
[3] 37 C.F.R. § 1.104(c) provides:

> In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

the Examiner could factually establish that Chase teaches computing an optimal cache size, the Examiner has not factually established that Chase identically discloses that the optimal cache size is computed "for said Zipf alpha coefficient, trace footprint and optimal hit rate," as recited in claims 1 and 11.

Claim 7

Claim 7 recites "an optimal cache size computation processor," and to teach this limitation the Examiner cited paragraphs [0035]-[0038] of Chase. Upon reviewing these paragraphs, Applicants note that although Chase teaches the size of cache is "M" and expressed in terms of objects, the Examiner has not establish that Chase identically discloses computing an optimal cache size. Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-16 under 35 U.S.C. § 102 for anticipation based upon Chase.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

> When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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